

REMARKS

The Examiner is thanked for performing a thorough search. In this reply, Claims 1, 10, and 31 have been amended. No claims have been added or canceled. Therefore, Claims 1-78 are pending in the present application.

SPECIFICATION

In the specification, the paragraph beginning on page 1, line 5 has been amended to add the serial number of a related patent application.

CLAIM REJECTIONS – 35 U.S.C. § 101

The Office Action rejected Claims 1-39 under 35 U.S.C. § 101 because Claims 1-39 allegedly are directed to non-statutory subject matter.

The Office Action alleges that 35 U.S.C. § 101 requires that the subject matter recited in Claims 1-39 be within the “technological arts.” However, in a recent precedential opinion, *Ex Parte Carl A. Lundgren*, Appeal No. 2003-2088 (April 20, 2004), the Board of Patent Appeals and Interferences held that 35 U.S.C. § 101 does **not** implicitly or explicitly contain any such requirement. In the *per curiam* decision, the Board concluded:

Our determination is that **there is currently no judicially recognized separate "technological arts" test** to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner’s rejection can not be sustained.

The Office Action additionally alleges that Claims 1-39 recite nothing more than an abstract idea. The Office Action apparently bases this conclusion on a determination

that the recited steps **could be performed in the mind of a user** or by use of pencil and paper. The Office Action posits that the preamble recitations of Independent Claims 1, 10, and 31, that the methods thereof are “computer-implemented,” are insufficient to avoid the determination that the methods are merely abstract ideas.

The Office Action’s reasoning seems dangerously close to the reasoning that the Court of Customs and Patent Appeals expressly **rejected** in 1970 in *In re Musgrave*, 431 F.2d 882, 167 USPQ 280. In that case, the Court **reversed** a 35 U.S.C. § 101 rejection that alleged that the rejected claims were “directed to non-statutory processes **merely because some or all of the steps therein can also be carried out in or with the aid of the human mind** or because it may be necessary for one performing the processes to think.” There seems to be little difference between the reasoning rejected in *Musgrave* and the reasoning set forth in the Office Action.

Nevertheless, in the interest of expediting prosecution, Independent Claims 1, 10, and 31 have been amended in this reply to recite that certain steps are performed “at an entity that is embodied in a machine.” It is respectfully submitted that the presence of this phrase is a “positive recitation in the claim as a whole to breathe life and meaning into the preamble[s]” of Independent Claims 1, 10, and 31.

Therefore, it is respectfully submitted that Claims 1-39 are patentable under 35 U.S.C. § 101.

CLAIM REJECTIONS – 35 U.S.C. § 102

The Office Action rejected Claims 1-27, 31-66, and 70-78 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2004/0133793 by Ginter et al. (“Ginter”).

Ginter was filed on June 25, 2003. The present patent application was filed on May 11, 2001. Because the present application has a filing date that is earlier than Ginter’s filing date, Ginter cannot be used to reject Claims 1-27, 31-66, and 70-78 under 35 U.S.C. § 102(e).

Therefore, it is respectfully submitted that Claims 1-27, 31-66, and 70-78 are patentable over Ginter under 35 U.S.C. § 102(e).

CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action rejected Claims 28-30 and 67-69 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ginter.

As is discussed above, the filing date of the present application precedes Ginter’s filing date. Consequently, Ginter cannot be used to reject the claims of the present application under 35 U.S.C. § 103(a).

Therefore, it is respectfully submitted that Claims 28-30 and 67-69 are patentable over Ginter under 35 U.S.C. § 103(a).

CONCLUSION

The Applicants believe that all issues raised in the Office Action have been addressed and that allowance of the pending claims is appropriate. Therefore, the Applicants respectfully request that a timely Notice of Allowance be issued in this case.

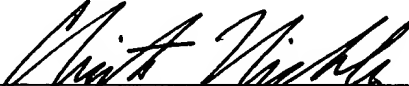
The Examiner is invited to telephone the undersigned at (408) 414-1080 to discuss any issue that may advance prosecution.

No fee is believed to be due specifically in connection with this reply. To the extent necessary, the Applicants petition for an extension of time under 37 C.F.R. § 1.136. The Commissioner is authorized to charge any fee that may be due in connection with this Reply to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: October 25, 2005

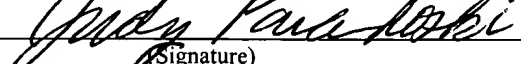

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

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